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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/981,025      | 10/16/2001  | Horst Dollinger      | I/1154              | 5630             |

28501 7590 04/03/2003

BOEHRINGER INGELHEIM CORPORATION  
900 RIDGEURY ROAD  
P. O. BOX 368  
RIDGEFIELD, CT 06877

[REDACTED] EXAMINER

WANG, SHENGJUN

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1617

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/981,025             | DOLLINGER ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Shengjun Wang          | 1617                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.  
     4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.  
 5) Claim(s) 1-27 is/are allowed.  
 6) Claim(s) 1-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) All b) Some \* c) None of:  
         1. Certified copies of the priority documents have been received.  
         2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

**DETAILED ACTION**

1. Claims 28-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, 17-20 are withdrawn from further consideration as being drawn to non-elected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5, submitted January 21, 2003.
2. Applicant's election with traverse of invention group I, claims 1-27, and compound disclosed in example 2 at page 15 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that invention groups I and II are linked, and there should not be an undue burden to search both groups. This is not found persuasive because the presence of a link between the two group does not necessarily make the two groups not patentable distinct. The inventions are distinct for reasons set forth in the prior office action. Further, search of group II with respect of treating diseases is not required for search of group I.

The requirement is still deemed proper and is therefore made FINAL.

The elected species was found allowable; the search has been extended to non-elected species (changing R1 and R2 in the elected compound). The claims have been examined insofar as they read on the searched species.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections 35 U.S.C. 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

-16, 21

5. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boehringer Ingelheim (WO 97/32865, which is US 6,498,162 equivalent).

Boehringer Ingelheim teaches compounds structurally similar to the compounds claimed herein, which are useful in pharmaceutical composition as neurokinin antagonist. See, particularly the table at page 17-18, example 16 at page 31, example 19 at page 32, and examples 54, 55 at page 44. The compounds are made by putting three building blocks, piperidine, phenyl acetate, and phenylethylene moieties together through conventional organic chemistry. See, the example 1. All the compounds listed above differ from the compounds defined herein (R1 is 3-hydroxypropyl, C5-cycloalkylmethyl; R2 is hydrogen, methyl, 2-hydroxylethyl) by a methylene unit. The instant compounds are structural homologs of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. In re Hass, 60 USPQ 544 (CCPA 1944);

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In re Henze, 85 USPQ 261 (CCPA 1950). As to claim 26, forming a tertiary amine by reaction of a secondary amine and alkyl with a leaving group is obvious for one of ordinary skill in the art.

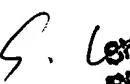
Also optimization of the sequence to link the building blocks together to make an organic compound is considered within the skill of artisan, absent evidence to the contrary. Further, making a pharmaceutical composition with a known therapeutical agent is within the skill of artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

  
SHENGJUN WANG  
PATENT EXAMINER

Shengjun Wang

April 1, 2003